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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

50277-2406

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Application Number

10/786,941

Filed

2/24/2004

First Named Inventor

Daniel Manhung Wong

Art Unit

2167

Examiner

Pham, Michael

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 61173
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☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

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10/15/2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant respectfully submits that the rejections in the Final Office Action and Advisory Action are predicated on clear errors of fact and erroneous applications of the law. Applicant respectfully requests this panel to reverse the rejections under 35 U.S.C. § 102(e), 35 U.S.C. § 103(a), and 35 U.S.C. § 112, first paragraph.

I. 35 U.S.C. § 102(e)

The Federal Circuit held that, “unless a reference discloses within the four corners of the document **not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim**, it cannot be said to prove prior invention of the thing claimed and, thus, **cannot anticipate under 35 U.S.C. § 102.**” *Net MoneyIN, Inc. v. Verisign, Inc.*, No. 2007-1565 (Fed. Cir. 2008).

Puz does not anticipate Claims 1-4, 6-9, 14-21, and 26 under 35 U.S.C. § 102(e). Puz does not show a tag that is (a) included in a request to execute a database statement, and (b) not embedded in the database statement, as claimed. Puz requires security markers to be embedded in a database statement. As explained in paragraph 28 of Puz: “The parse tree is analyzed and, for each database object involved in the query, an appropriate **security marker is inserted into the SQL string.**” Specifically, paragraph 28 (describing element 50 of FIG. 2, which was relied upon by the Advisory Action) states: “Thus, **the SQL string is divided into multiple query parts 34, 36, 38, each query part including an SQL part 40, 42, 44 and a respective security marker 46, 48, 50.**”

In addition to describing the security markers as embedded in the database statement, Puz requires the security markers to be embedded in the database statement in order to produce a final statement for execution. In Puz (par. 33), the security marker is a placeholder embedded in the database statement. As described in Puz, a server receives the SQL string with the embedded security marker, and “each security marker is replaced with respective SQL joins and conditions to form a final SQL string for submission to a DBMS (84).” Puz explains (pars. 33 and 38): “The final SQL string includes the client SQL (SQL parts) and the server-generated SQL, forming a single, final SQL string.” If the security markers were not embedded in the SQL string, then replacing the security markers with SQL text would not produce the final SQL string with the substituted SQL

text to be executed by the DBMS. In other words, the security markers in Puz must be embedded in the database statement in order to produce the result described by Puz. Thus, Puz cannot show a tag that is (a) included in a request to execute a database statement, and (b) not embedded in the database statement.

Further, Puz does not have access to a parameter value of a tag during execution of the database statement. In fact, the security marker of Puz is not used at all during execution of the database statement. After the security marker has been replaced with respective SQL joins and conditions (pars. 33 and 38), the security marker is no longer in the final SQL string that is submitted to the DBMS for execution.

For at least these reasons, the rejections of Claims 1-4, 6-9, 14-21, and 26 are predicated on clear errors of fact and erroneous applications of 35 U.S.C. § 102(e). Applicant respectfully requests this panel to reverse the rejections of Claims 1-4, 6-9, 14-21, and 26 under 35 U.S.C. § 102(e).

II. 35 U.S.C. § 103(a)

In *KSR Int'l Co. v. Teleflex Inc.* (2007), the Supreme Court reiterated (citing *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006): “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

Applicant respectfully submits that the rejections of Claims 5, 10-13, and 22-25 under 35 U.S.C. § 103(a) lack the rational underpinning required by law. As discussed above with respect to the rejections under 35 U.S.C. § 102(e), Puz (pars. 28, 33, and 38) requires security markers to be embedded in a database statement. Puz does not show a tag that is (a) included in a request to execute a database statement, and (b) not embedded in the database statement.

As discussed, Puz requires the security markers to be embedded in the database statement in order to produce the final SQL string to be executed by the DBMS. A placeholder, by its very nature, cannot be separated from the database statement in which it is holding a place. For at least these reasons, the recited tags, which are (a) included in a request to execute a database statement, and (b) not embedded in the database

statement, would not have been obvious to a person of ordinary skill in light of the placeholding security markers of Puz.

Further, as discussed above with respect to the rejections under 35 U.S.C. § 102(e), Puz does not have access to a parameter value of a tag during execution of the database statement. In fact, Puz does not use the security marker at all during execution.

Fujiwara does not fill the fundamental gaps left by Puz. Fujiwara (paragraph 73) mentions references to masked columns that are embedded in a database statement and then replaced by corresponding function calls. Fujiwara explains: “As can be seen the translation process 1210 is simply a textual replacement in the original query of the masked column references by their corresponding function calls.” Replacing text that is embedded in a database statement, as mentioned in both Puz and Fujiwara, does not show the recited tags, which are (a) included in a request to execute a database statement, and (b) not embedded in the database statement. Therefore, the teachings of Puz and Fujiwara, even if combined, fail to show the recited tags.

The Final Office Action and Advisory Action fail to articulate any reasoning with some rational underpinning to support the erroneous conclusion that Claims 5, 10-13, and 22-25 would have been obvious in light of information that is not embedded in the database statement. Unlike the cited art, the recited tags are (a) included in a request to execute a database statement, and (b) not embedded in the database statement. For at least these reasons, the rejections of Claims 5, 10-13, and 22-25 are predicated on clear errors of fact and erroneous applications of 35 U.S.C. § 103(a). Applicant respectfully requests that this panel reverse the rejections of Claims 5, 10-13, and 22-25 under 35 U.S.C. § 103(a).

III. 35 U.S.C. § 112, FIRST PARAGRAPH

The specification as filed explicitly describes Claims 1-26 in a way that reasonably conveys to a person of ordinary skill in the art that the inventor had possession of the claimed invention. Applicant’s specification (paragraphs 22, 33-34, and 37) provides numerous non-limiting examples of a tag that is (a) included in a request to execute a database statement, and (b) not embedded in the database statement.

For example, paragraph 22 states: “Tag 103b includes control information such as information related to priority, quality of service, user identification, security, and/or

user supplied routines that is **appended to, attached to, sent with,** embedded in **or otherwise associated with database statement 103a.**” In other words, the specification explicitly describes techniques where the tag is (a) included in a request to execute a database statement (appended to, attached to, sent with, or otherwise associated with), and (b) not embedded in the database statement.

Further, paragraphs 33-34 provide a non-limiting example of an “execution interface” for receiving a request that includes a database statement and a control tag. As described in paragraph 33, “statement” is one argument of DBMS_SQL.PARSE(), and “control tag” is another argument of DBMS_SQL.PARSE(). As further explained in paragraph 34, “the execution interface may be DBMS_SQL.PARSE(cursr, ‘SELECT * FROM emp’, v7, ‘resource=g1 id=scott’).” In the non-limiting example, the database statement, “SELECT * FROM emp,” conforms to SQL, and the control tag, “resource=g1 id=scott,” is not embedded in the database statement.

In another non-limiting example of paragraph 37, the tag can be sent in XML rather than in a SQL database statement.

For at least the reasons provided above, the specification as filed explicitly describes the claimed subject matter in a way that reasonably conveys to a person of ordinary skill in the art that the inventor had possession of various embodiments where a tag is (a) included in a request to execute a database statement, and (b) not embedded in the database statement. Therefore, Applicant respectfully requests withdrawal of the erroneous rejection of Claims 1-26 under 35 U.S.C. § 112.

IV. CONCLUSION

For at least the reasons provided above, Applicant respectfully requests this panel to reverse the rejections under 35 U.S.C. § 102(e), 35 U.S.C. § 103(a), and 35 U.S.C. § 112, first paragraph.

Respectfully submitted,

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Dated: October 15, 2010

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